

## **REMARKS/ARGUMENTS**

In response to the Examiner's comments in section I. of the Office Action mailed August 21, 2003, Applicants traverse the comment to the extent it may be read to imply that Applicants have "agreed" to the statement "The record shows that (1) the second compound with respect to "surfactant" in the canceled claim 2 and now in the amended claim 1 is considered as optional or obvious to one having ordinary skill in the art for using them either one alone or their combination as clearly pointed out and set forth in the Office action mailed on 27 March 2003". Applicants have made no such "agreement", and to the contrary have explicitly explained why the present developer solutions comprising a combination of thickener and surfactant providing the claimed viscosity and surface tension are unique and patentable over the prior art.

In response to the Examiner's "NEW (3)" comments in section II. of the Office Action, Applicants note that while the Office under certain circumstances may possess the authority to require the applicant to prove that subject matter shown to be in the prior art does not possess claimed characteristics, such authority only is relevant where the Office has set forth a reasonable basis for believing that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, and where the applied prior art is not otherwise clearly differentiated from the claimed invention. As further discussed below, the Examiner has failed to establish such reasonable basis with respect to the present claimed invention.

Claims 1 and 5-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al (5,891,608). The Examiner states that Hashimoto et al disclose, teach, suggest, demonstrate and reduce to practice with an aqueous silver halide color developing solution comprising a color developing agent as elected and a thickening agent as elected and having up to 100 poises. Please see the whole disclosure of the applied reference, especially at the Example 1, TABLE 1, Sample No. 1 and Example 2, TABLE 3, Samples 21 and 27. Since Hashimoto et al disclose, teach, suggest, demonstrate and reduce to practice with the claimed invention using the elected species, the above claims are found to be anticipated by Hashimoto et al. This rejection is respectfully traversed.

The Examiner's reliance upon Sample No. 1 in Example 1 and Samples Nos. 21 and 27 as disclosing an aqueous developing solution having a viscosity of 100 poise is not supported. The cited samples actually disclose

“processing compositions” in slurry form (see, e.g., Summary of the Invention; col. 2, lines 46-52; col. 17, lines 51+; col. 37, lines 19-23; col. 57, lines 13-25), as opposed to developer solutions, with viscosities of 30, 25, and 4 poise, respectively (see final column of cited tables). Note further that the indicated “100” poise values for each of the cited Hashimoto et al samples refers only to the viscosity of a 1 wt% aqueous solution of a water-soluble polymer used therein (as explained at col. 37, lines 49-52, and col. 17, lines 41-50), rather than viscosity of the processing composition itself (which, as explained above, is reported to be either 30, 25 or 4 poise). Thus, the cited examples are distinguished from the present claimed invention in that they refer to slurry compositions (i.e., where the developer is dispersed in the form of solid particles), rather than developer solutions (where developer is actually in solution), and in that such slurry compositions have lower viscosities than that required in the present claims. The difference between the cited slurry compositions and the claimed developer solution is fundamental, as such slurry compositions would not be capable of being effectively used for direct application (the solid particles would be substantially inactive), while the developer solutions of the invention are expressly intended and taught for direct application use. Thus such examples clearly do not anticipate the present claimed invention.

As further previously noted, while the broad preferred viscosity range of the concentrated slurry-form compositions of Hashimoto et al may overlap with the claimed required viscosity of the developer solutions of the present invention, there is no disclosure of formulating a composition at the upper end of such preferred range (e.g., from 5,000-10,000 cP, which is above the “more preferred” upper limit of 50 poise (5,000 cP)), while also employing a surfactant effective at providing a surface tension of less than 30 dyne/cm. Note the specific examples of Hashimoto disclose processing composition viscosities of either at most 30 poise (3,000cP), or greater than 1800 poise (180,000 cP), and unspecified surface tensions. In any event, it is further noted that even if the Examiner were to continue to attempt to rely upon the broadly cited viscosity range of 0.1 to 100 poise cited in Hashimoto et al for the processing compositions thereof as a basis for “anticipation” of the present claimed invention, the requirement that such compositions in the cited art be in slurry form clearly distinguishes the disclosed compositions from the developer solutions of the present invention. Accordingly, Hashimoto et al clearly cannot anticipate the present claimed invention, and a requirement for a “showing” over the applied reference is clearly inappropriate. Reconsideration of such anticipation rejection is accordingly respectfully requested.

Claims 1 and 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al (5,89,608). The Examiner states that the basis for the rejection is essentially the same as that with respect to the rejection under 102(b), with an addition that compounds are not used in the Examples but disclosed, taught and suggested in Hashimoto et al at col. 2:34-36 and 46-51, 3:29 to 17:50, 18:7 to 19:42, 22:66 to 25:24 are found to be obvious variants and conventional additives in the photographic art as disclosed, taught and suggested by Hashimoto et al., and states that Applicants should show or provide an evidence to the contrary. This rejection is respectfully traversed.

As explained above, Hashimoto et al is clearly distinguished from the claimed invention, as there is no disclosure of the use of thickeners and surfactants in a developer solution sufficient to provide a viscosity of between about 5,000 and about 30,000 cP and a surface tension of less than 30 dyne/cm. A review of Hashimoto et al clearly reveals that there is no disclosure, teaching or suggestion to modify the specific examples thereof with additional components so as to drastically change the resulting properties thereof, and to further change the fundamental nature thereof from a slurry to a solution, so as to be within the current claim scope. This is clear as Hashimoto et al is concerned only with formulating a concentrated slurry-form composition, which only upon proper dilution (and dissolution of the solid particles of the slurry composition) may form a conventional developer solution, as opposed to a developer solution optimized for direct application in digital film processing as described in the present application.

Note specifically, as previously explained, that the digital film processing method described in the specification poses unique challenges compared to conventional film processing techniques. In particular, as described in the present application, in digital film processing the film is scanned through a coated layer of developer solution. Therefore, any substantial unevenness in the layer of developer solution on the film can adversely affect the scanning process. Applicants have found that the claimed surface tension (see, e.g., page 13, lines 20-30) and viscosity (see, e.g., page 16, lines 1-6) requirements for the claimed developer solution are important to providing a uniform thin, even layer of developer solution on the film, particularly when a slot coater is used to apply the developer solution in the manner described in the application. As Hashimoto et al is directed towards the preparation of slurry compositions ultimately intended for use in conventional solution processing of photographic materials (after dilution and dissolution of the solid particles therein), rather than directed towards providing a developer solution optimized for use in providing a uniform coating in digital film processing, there can be no motivation found to modify the slurry

compositions disclosed therein in order to provide the developer solutions having the combined surface tension and viscosity as required by the instant claims.

Further, even if the slurry compositions of Hashimoto et al. were to be modified to have viscosity and surface tensions in accordance with the instant claims, such slurry compositions would not be developer solutions which may be used in accordance with present invention. In view of the fundamental differences between concentrated slurry compositions intended for subsequent dilution (and requiring dissolution of solid material contained therein prior to use) and the developer solutions (which solutions may be directly applied) of the present invention, a requirement for Applicants to provide any comparison test relative to the slurry formulation is clearly inappropriate. Reconsideration of this rejection is accordingly respectfully requested.

It is assumed the Examiner has applied what he considers to be the closest prior art with respect to the claimed invention, in view of his duty to avoid piecemeal examination. The Examiner's reference to Abe (5,998,111) as "next in line to be applied" is noted. While the Examiner's position with respect to such reference is not clear in view of the above cited duty, Applicants submit the following comments in an effort to expedite prosecution. To the extent the Examiner is alleging that such reference may anticipate or make obvious the present claimed invention, Applicants note that such reference is largely redundant to Hashimoto et al., as Abe similarly is directed towards the preparation of concentrated processing agent compositions comprising dispersed/suspended solid components, which compositions are intended for subsequent dilution and dissolution of solid components. Thus, it is clear such reference does not anticipate or make obvious Applicants' claimed developer solution having required viscosity and surface tension requirements. It is also noted that Abe expressly teaches against kinematic viscosity values of greater than  $25 \text{ cm}^2/\text{sec}$  (see, e.g., col. 8 lines 3-11, and col. 9, lines 11-23). As the aqueous based compositions of Abe would be expected to have densities of reasonably close to  $1 \text{ g/cm}^3$  (and in any event substantially less than  $2 \text{ g/cm}^3$ ), such kinematic viscosity upper limit would translate into an absolute viscosity upper limit of substantially less than 50 poise (i.e., substantially less than  $(25 \text{ cm}^2/\text{sec}) \times (2 \text{ g/cm}^3)$ ).

It is further noted that withdrawn independent claims 17, 32, and 50 have been previously amended to be consistent with and include all the limitations of the present elected claim 1. Rejoinder of withdrawn pending claims 17, 22-36, 39-53, and 55-62 is again respectfully requested upon allowance of pending claims 1 and 5-16.

In view of the foregoing remarks, reconsideration of this patent application is respectfully requested. A prompt and favorable action by the Examiner is earnestly solicited. Should the Examiner believe any remaining issues may be resolved via a telephone interview, the Examiner is encouraged to contact Applicants' representative at the number below to discuss such issues.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew J. Anderson', written over a horizontal line.

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